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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/556,457

11/17/2006

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21295.0119US1

3776

29127 7590 06/08/2009  
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EXAMINER

CHAPEL, DEREK S

ART UNIT

PAPER NUMBER

2872

MAIL DATE

DELIVERY MODE

06/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/556,457	<b>Applicant(s)</b> SEIFERT ET AL.	
	<b>Examiner</b> DEREK S. CHAPEL	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status Of Claims***

1. This Office Action is in response to an amendment received 3/17/2009 in which Applicant lists claims 1-16 as being as being currently amended. It is interpreted by the examiner that claims 1-16 are pending.

### ***Drawings***

2. The amendments to the specification were received on 3/17/2009. These amendments are accepted. The objections to the drawings cited in the office action mailed 12/24/2008 are hereby withdrawn.

### ***Specification***

3. The amendments to the specification dated 3/17/2009 are accepted. The objections to the specification cited in the office action mailed 12/24/2008 are hereby withdrawn.

### ***Claim Objections***

4. The amendments to the claims dated 3/17/2009 are accepted. The objections to the claims cited in the office action mailed 12/24/2008 are hereby withdrawn.

5. Claims 1-16 are objected to because of the following informalities: claims 1 and 15 contains "and/or" creating uncertainty as to the metes and bounds of the claims. Is the device for transferring and tilting an object, or for transferring or tilting an object, or both? For the purpose of this examination, "and/or" has been interpreted as --or--.

Further, "rotational axis *may be* changed by the rotation guiding the carrier" in claims 1

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and 15 creates uncertainty as to the metes and bounds of the claims. Is the rotational axis changed or not? Finally, “a control lever *may be* inserted into the carrier” in claim 10 creates uncertainty as to the metes and bounds of the claim. Is the lever inserted or not? Claims 2-14 and 16 are objected to for inheriting the same informalities through their dependency from claims 1 and 15. Appropriate correction is required.

6. Claim 11 recites the limitation “the guide element”. There is insufficient antecedent basis for this limitation in the claim. Claim 12 is objected to for inheriting the same informalities through its dependency from claim 11. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5 and 13, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Nakane et al., U.S. Patent Number 5,374,972 (hereafter Nakane).

9. As to claim 1, Nakane discloses a fine tuning device for transferring or tilting an object (see at least figure 1, element P) comprising:

a guide (see at least figure 1, the left roller carrying element 24) defining a rotational axis (see at least figure 1, the center axis of the left roller carrying element 24) and

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a carrier (see at least figure 1, element 24) bearing the object (see at least figure 1, element P), the carrier being rotatable around the rotational axis guided by the guide (see at least figure 1), wherein

the angle between the carrier and the rotational axis may be changed by the rotation guiding the carrier along a guide plane on the guide at an angle other than 90° to the rotational axis or,

the object is offset from the center of the carrier (see at least figure 2, elements P1 or P2, which are offset from a center line running lengthwise along the carrier) and is movable with respect to the rotational axis by rotation of the carrier around the rotational axis (see at least figure 1).

10. As to claim 2, Nakane discloses that the guide is guided by a further guide around the rotational axis or a further rotational axis (see at least figure 1, the roller above, to the right of or below the left roller carrying element 24).

11. As to claims 3 and 4, Nakane discloses a second fine tuning device (see at least figure 1, element 25) comprising:

a guide (see at least figure 1, element 25) defining a rotational axis (see at least figure 1, the center axis element 25) and

a carrier (see at least figure 1, the conveyor running over element 25) bearing the object (see at least figure 1, element P), the carrier being rotatable around the rotational axis guided by the guide (see at least figure 1), wherein

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the angle between the carrier and the rotational axis may be changed by the rotation guiding the carrier along a guide plane on the guide at an angle other than 90° to the rotational axis or,

the object is offset from the center of the carrier (see at least figure 2, elements P1 or P2, which are offset from a center line running lengthwise along the carrier) and is movable with respect to the rotational axis by rotation of the carrier around the rotational axis (see at least figure 1).

12. As to claim 5, Nakane discloses that the carrier or the guide or a further guide are round in cross-section (see at least figure 1, the left roller carrying element 24, and element 25).

13. As to claim 13, Nakane discloses that the elements that touch each other directly are made of different materials (see at least figure 1, elements P and 24).

14. Claims 1-2, 5-6, 10-12 and 14-15, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Toyoda et al., U.S. Patent Number 5,337,177, of record (hereafter Toyoda).

15. As to claims 1 and 15, Toyoda discloses a microscope (see at least figures 1 and 2) comprising a fine tuning device for transferring or tilting an object (see at least figure 2, element 7b or 7a) comprising:

a guide (see at least figure 2, element 2) defining a rotational axis (see at least figure 2, element 6) and

a carrier (see at least figure 2, element 1) bearing the object (see at least figure 2, element 7b or 7a), the carrier being rotatable around the rotational axis guided by the guide (see at least figure 2 as well as column 5, lines 1-10), wherein

the angle between the carrier and the rotational axis may be changed by the rotation guiding the carrier along a guide plane on the guide at an angle other than 90° to the rotational axis or,

the object is offset from the center of the carrier (see at least figure 2, element 7b or 7a) and is movable with respect to the rotational axis by rotation of the carrier around the rotational axis (see at least figure 2 as well as column 5, lines 1-10).

16. As to claim 2, Toyoda discloses that the guide is guided by a further guide around the rotational axis or a further rotational axis (see at least figure 2, the dovetail section of element 3 above element 1).

17. As to claim 5, Toyoda discloses that the carrier or the guide or a further guide (see at least figure 2, the dovetail section of element 3 above element 1) are round in cross-section (see at least figure 2, the dovetail section of element 3 above element 1; it is noted that the dovetail section must be round for element 1 to be rotated without changing the orientation of element 3).

18. As to claim 6, Toyoda discloses that the guide comprises a recess within which the carrier can be rotated (see at least figure 2, elements 1 and 2).

19. As to claim 10, Toyoda discloses that a control lever may be inserted into the carrier or the guide or a further guide (see at least figure 4, element 15).

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20. As to claim 11, Toyoda discloses that the guide or a further guide can be moved in the direction of the rotational axis or a further rotational axis (see at least figure 2, element 3; it is noted that the ocular could be rotated with respect to element 1 (as shown) or can be removed and moved up and away from the microscope body for changing).

21. As to claim 12, Toyoda discloses that the guide or the further guide comprises a screw thread (see at least figure 2, elements 5b and 5a).

22. As to claim 14, Toyoda discloses that the object is an optical component or an objective (see at least figure 2, elements 7a and 7b).

23. Claims 1, 6-7 and 15, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Schalz et al., U.S. Patent Number 5,539,573 (hereafter Schalz).

24. As to claims 1 and 15, Schalz discloses a microscope (see at least figures 1 and 2) comprising a fine tuning device for transferring or tilting an object (see at least figures 1 and 2, elements 2, 9 or 3) comprising:

a guide (see at least figures 1 and 2, elements 12, 12' and 4') defining a rotational axis (see at least figures 1 and 2, element 12 or 12') and

a carrier (see at least figures 1 and 2, element 7 or 8) bearing the object (see at least figures 1 and 2, elements 2, 9 or 3), the carrier being rotatable around the rotational axis guided by the guide (see at least figures 1 and 2), wherein



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the angle between the carrier and the rotational axis may be changed by the rotation guiding the carrier along a guide plane on the guide at an angle other than 90° to the rotational axis or,

the object is offset from the center of the carrier (see at least figures 1 and 2, elements 2, 3, 7, 8 and 9) and is movable with respect to the rotational axis by rotation of the carrier around the rotational axis (see at least figures 1 and 2).

25. As to claim 6, Schalz discloses that the guide comprises a recess within which the carrier can be rotated (see at least figures 1 and 2, the holes in 4' for elements 12 and 12').

26. As to claim 7, Schalz discloses that the recess is eccentric (see at least figures 1 and 2, the holes in 4' for elements 12 and 12'; it is noted that the holes are not situated in the center (vertically) of elements 4', 7 or 8).

27. Claims 1, 8 and 9, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hopkins, U.S. Patent Number 3,994,557 (hereafter Hopkins).

28. As to claim 1, Hopkins discloses a fine tuning device for transferring or tilting an object (see at least figure 1, element 44) comprising:

a guide (see at least figure 1, element 34) defining a rotational axis (see at least figure 1, element 34) and

a carrier (see at least figure 1, elements 36B or 42) bearing the object (see at least figure 1, element 44), the carrier being rotatable around the rotational axis guided by the guide (see at least figure 1), wherein

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the angle between the carrier and the rotational axis may be changed by the rotation guiding the carrier along a guide plane on the guide at an angle other than 90° to the rotational axis or,

the object is offset from the center of the carrier (see at least figure 1, elements 44 and 36B) and is movable with respect to the rotational axis by rotation of the carrier around the rotational axis (see at least figure 1, elements 34, 38 and 40).

29. As to claim 8, Hopkins discloses a further guide (see at least figure 1, element 22) comprising a recess within which the guide can be rotated (see at least figure 1, elements 34 and 22; it is noted that rotating 18B in 22 causes a rotation of 34).

30. As to claim 9, Hopkins discloses that the recess is eccentric (see at least figure 1, elements 22 and 34; it is noted that 22 and 34 do not share the same center or axis).

### ***Claim Rejections - 35 USC § 103***

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

33. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

34. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al., U.S. Patent Number 5,337,177, of record (hereafter Toyoda).

35. As to claim 16, Toyoda does not specifically disclose that the microscope is a scanning microscope, a confocal scanning microscope, a 4 pi microscope, or a theta microscope.

However, Official Notice is taken that scanning microscopes, confocal scanning microscopes, 4 pi microscopes, and theta microscopes are all well known types of microscopes.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the microscope of Toyoda with either a scanning microscope, a confocal scanning microscope, a 4 pi microscope, or a theta microscope for at least the purpose of capturing specific desired images of a specimen.

***Response to Arguments***

36. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

38. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEREK S. CHAPEL whose telephone number is (571)272-8042. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S. C./  
Examiner, Art Unit 2872  
6/2/2009

/Stephone B. Allen/  
Supervisory Patent Examiner  
Art Unit 2872